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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,360	12/11/2001	Jean-Claude Pailles	214946US2PCT	9239
22850	7590	05/12/2010	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			WORJLOH, JALATEE	
			ART UNIT	PAPER NUMBER
			3685	
			NOTIFICATION DATE	DELIVERY MODE
			05/12/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/926,360	Applicant(s) PAILLES ET AL.	
	Examiner Jalatee Worjloh	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5-15-2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 23-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 19, 2010 has been entered.
2. Claims 23-37 are pending.

Response to Arguments

3. Applicants' arguments filed January 19, 2010 have been fully considered but they are not persuasive.
4. Applicants' argue that Floyd does not expressly disclose "analyzing conditions based on previous use of the software to determine whether a further payment relating to the software is required for continued use".

The Examiner notes that the phrase "to determine whether a further payment relating to the software is required for continued use" is an intended use feature. Functional recitation(s) using the word "for" or other functional language (*e.g.* "to determine") have been considered but are given little patentable weight¹ because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is

¹ See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

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capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

Also, as expressed in the Office Action, Floyd teaches making payment for continuous use of a software. Therefore, it would have been obvious to modify the system of Downs to include the features of Floyd.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 23-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Particularly, the specification does not support further payment for a software being required for continued use. However, if Applicants disagree, please indicate where this feature is described in your specification.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

although all limitations must be considered, not all limitations are entitled to patentable weight).

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 23-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 23, 36, and 37 recite analyzing conditions based on previous use of the software to determine whether a further payment relating to the software is required for continued use, but does not describe making an initial payment. It is unclear whether an initial payment was made. Therefore, for examination purposes, the Examiner interprets the payment in the claims as the first payment being made.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 23-26, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6226618 to Downs et al. ("Downs") in view of US Patent No. 6243692 to Floyd et al. ("Floyd").

Referring to claim 23, Downs discloses a terminal configured to access software stored on a computer readable storage linked thereto, control means for analyzing conditions based on previous use of the software (see col. 7, lines 5-10 -control and enforcement of content usage according to the conditions of purchase or license, such as number of plays), and configured to

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generate and transmit a first message, which is an offer message, containing at least an identity of the software owner, offer parameters and a digital signature of the software owner for at least part of the offer parameters (see col. 18 table, steps 130-135; col. 7, lines 56- 67 - the digital content store offers the digital content which is part of the content SC; the license key allows the user continues use of the content), payment means linked to the terminal and configured to receive the first message, display the first message, receive an acceptance of the software user, compose a second message requesting payment which includes at least the identity of the user, and of the software owner together with proof of the user acceptance, and configured to transmit the second message (see col. 18, step 136 - the user adds the digital content to his shopping card and submits it), a message and payment processing system (i.e. clearinghouse) configured to receive the second message, verify the proof of user acceptance, record the payment request with at least the identity of the user and of the software owner and the amount to be paid, credit the owner with the amount to be paid, configured to compose a third message which serves as a payment settlement message, the third message containing at least the identity of the message and payment processing system and a digital signature for proof of payment, and to transmit the third message therefrom (see col. 19, steps 137 & col. 23, lines 56-67; col. 24, lines 1-4 - transaction SC & Offer SC). Downs does not expressly disclose determining if a payment relating to the software is required for continued use. Floyd discloses this feature (see abstract; fig. 5, and related text). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Downs to include the features of Floyd. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized usage of the software.

Referring to claim 24, Downs discloses the system whereby the digital signature of the owner of at least part of the offer, and the digital signature for proof of payment are both public key signatures with certification trees, so that an authority defines the root of the certification tree containing the system's different participants, notably a software owner and the message and payment processing server, and one or more certificates are attached to the first and third message for signature checking (see col. 13 & col. 14 - "Digital Signatures" and "Digital Certificates").

Referring to claim 25, Downs discloses whereby the message and payment processing server further comprises: a remote payment server linked to the payment module by a telecommunications network, and whereby said remote payment server receives and processes the second message and composes and sends the third message; the remote payment server calculates a total consumption of each user for all software owners in order to impose payment by said user and causes the sums owed to each software owner to be transferred by all of the users.

Referring to claim 26, Downs discloses whereby the message and payment processing server further comprises secure means containing at least the identity of the user; said means are additionally able to receive the second message, check the proof of the user acceptance, record the payment request and compose the third message, payment settlement, transfer the third message, and also includes a remote payment server able to credit the software owner (see claim 23 above).

Claims 36 and 37 are rejected on the same rationale as claim 23 above.

12. Claims 27-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs and Floyd as applied to claim 26 above, and further in view of US Patent No. 6105008 to Davis et al. (“Davis”).

Referring to claims 27-31, Downs discloses the feature of claim 26. However, Downs does not expressly disclose the secure means include a smart card reader with a smart card containing the user’s identity, and whereby the reader and card are able to receive the second message, check the proof of the user acceptance, record the payment request and compose the third message. Davis discloses a secure means include a smart card reader with a smart card containing the user’s identity, and whereby the reader and card are able to receive the second message, check the proof of the user acceptance, record the payment request and compose the third message, whereby the card is of a prepay type and contains a balance and whereby the card is able to debit the balance with the request amount at each payment request, whereby the prepay card message insert into the third message proof that the requested amount has been debited from the card, whereby the prepay card is able to update a file containing settled requests and corresponding amounts, and whereby a payment settlement message is only sent with a once this file has been updated, whereby the prepay card transfer and the file to the remote payment server during the topping-up process, for transferring funds to the software owners (see abstract & col. 7, lines 53-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the Downs to include the features of Davis. One of ordinary skill in the art would have been motivated to do this because it prevents fraud by ensuring that only confirmed payments are settled.

Referring to claim 32, Downs discloses the system of claim 28. Downs does not expressly disclose a wallet. Davis discloses the prepay card is of the electronic wallet type (see col. 7, lines 40-50). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Downs to include a wallet. One of ordinary skill in the art would have been motivated to do this because it wallets are an efficient means of storing user's payment information, certificate and shipping information for fast transactions.

Referring to claim 35, Downs discloses whereby the file is transferred to the remote payment server for transferring funds to the software owners (see claim 23 above).

Conclusion

13. Functional recitation(s) using the word “for” or other functional language (e.g. “in order to”, “able to”, “to determine”) have been considered but are given little patentable weight² because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See

² See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

14. Although the conditional elements have been considered, Applicant is reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See MPEP §2106 II. C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]"

15. "A whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and 571-273-6714 for Non-Official /Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/
Primary Examiner, Art Unit 3685